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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,151	01/08/2001	James S. Boyce	10003916-1	6995

7590 04/21/2005
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

MENBERU, BENIYAM

ART UNIT PAPER NUMBER

2626

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/757,151	BOYCE, JAMES S.	
	Examiner	Art Unit	
	Beniyam Menberu	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments, see page 5, filed November 1, 2004, with respect to the rejection(s) of claim(s) 1, 7, and 13 under U.S. Patent No. 5559933 to Boswell have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent No. 6606163 to Suzuki et al.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 17 recites the limitation "elements irresolvable by the printer" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2626

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 7, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6606163 to Suzuki et al.

Regarding claims 1, 7, and 13, Suzuki et al disclose a method, system, and program for delivering a file from a client to a server for printing, the method comprising:

- (a) receiving a path and a name of the file (column 45, lines 5-14);
- (b) discovering a file type of the file (column 36, lines 21-29); and,
- (c) responsive to a print ready file type, initiating a write of the file to the server (Fig. 24 step s2107; If the document does not need format conversion which means it is print ready, then it goes to step s2111 followed by s2112 where the document is sent to printer queue which reads on writing of the file to the server.).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 2, 8, and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6606163 to Suzuki et al in view of U.S. Patent Application Publication No. US 2002/0083341 A1 to Feuerstein et al.

Regarding claims 2, 8, and 14, Suzuki et al teach all the limitations of claims 1, 7, and 13 respectively. Suzuki et al performs comparison of file format, however Suzuki et al does not disclose the method of claim 1 wherein the name of the file includes an extension and wherein discovering the file type includes:

- (a) comparing the extension of the file to a list of print ready extensions; and ,
- (b) responsive to a match between the extension of the file and a print ready extension, realizing the file type is print ready.

Feuerstein et al disclose method of comparing file extensions with a list of valid file extension (page 4, paragraph 53).

Suzuki et al are combinable because they are in the similar problem area of printing of files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine file extension comparison of Feuerstein et al with the print system of Suzuki et al to implement file extension based printing of files.

The motivation to combine the reference is clear because the file extension is used to describe the type of file thus the extension is needed to determine if it is print ready file.

4. Claims 3, 9, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6606163 to Suzuki et al in view of U.S. Patent No 6650431 to Roberts et al.

Regarding claims 3, 9, and 15, Suzuki et al teaches all the limitations of claim 1, 7, and 13 respectively. However Suzuki et al does not disclose method, system, and program for discovering the file type by analyzing contents of the file.

Roberts et al disclose method, system, and program (column 24, lines 36-67) for discovering the file type by analyzing contents of the file (Figure 2, reference, 204, 206,208; column 8, lines 14-34).

Suzuki et al and Roberts et al are combinable because they are in the similar problem area of printing of files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine file content analysis of Roberts et al with the print system of Suzuki et al to implement file content based method of discovering print ready files.

The motivation to combine the reference is clear because some files have code inside the file which determines the file type thus it is necessary to examine the inside of the file.

5. Claims 4, 5, 10, 11, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6606163 to Suzuki et al in view of U.S. Patent No. 5963641 to Crandall et al.

Regarding claims 4, 10, and 16, Suzuki et al teach all the limitations of claims 1, 7, and 13 respectively. However Suzuki et al does not disclose method, system, and

program to implement the method, system, and program of claims 1, 7, and 13 further including:

- (a) analyzing contents of the file to discover elements irresolvable by a printer; and,
- (b) resolving the elements of the file irresolvable by the printer.

Crandall et al discloses an apparatus and computer program to implement the method of analyzing contents of print files for irresolvable elements such as fonts, images, and patterns and correcting them (column 1, lines 50-52, column 1, lines 28-35, column 2, lines 2-4).

Suzuki et al and Crandall et al are combinable because they are in the similar problem area of printing of files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the analysis of irresolvable elements of Crandall et al with the print system of Suzuki et al to implement printing with correction of irresolvable elements.

The motivation to combine the reference is clear because Crandall et al teaches that before printing a check needs to be performed to make sure all the elements can be printed (column 1, lines 28-35).

Regarding claims 5, 11, and 17, Suzuki et al in view of Crandall et al teach all the limitations of claims 4, 10, and 13 (Suzuki et al). Further Crandall et al disclose the method of claim 4 wherein the elements irresolvable by the printer include fonts, images, and patterns irresolvable by the printer (column 1, lines 50-52; column 1, lines 28-35; column 2, lines 2-4).

6. Claims 6, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6606163 to Suzuki et al in view of U.S. Patent No. 6268924 to Koppolu et al.

Regarding claims 6, 12, and 18, Suzuki et al teaches all the limitations of claims 1, 7, and 13 respectively. However Suzuki et al does not disclose method, system, and program to open user interface for providing users with printing options.

Koppolu et al disclose method, system, and program to open user interface for providing users with printing options (Figure 5, reference 203; column 15, lines 41-45).

Suzuki et al and Koppolu et al are combinable because they are in the similar problem area of printing of files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the user interface taught by Koppolu et al with the print system of Suzuki et al to implement options for users to select before printing.

The motivation to combine the reference is clear because printer users need options to select before printing.

Other Prior Art Cited

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6373585 to Mastie et al disclose print job queues with balancing.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

BM

04/16/2005

KAW Williams
KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER